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10/518,873	12/20/2004	Jochen Fink	PP/I-22699/A/CGM 515/PCT	3532

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/518,873
Filing Date: December 20, 2004
Appellant(s): FINK ET AL.

Tyler A. Stevenson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3-31-08 appealing from the Office action mailed 10-31-07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,444,754	Chin et al.	9-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 7-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chin et al. (US 6,444,754).

Patentees in Example 3 disclose a process in which a polystyrene produced by polymerization of styrene in the presence of a nitroxyl compound having a glycidyl group is contacted at 235-275 degrees centigrade with thermoplastics having epoxy

reactive groups such as polyamide or PPE. Note Example 3 in this re and also that styrenic block copolymer is present. Since the glycidyl group containing polystyrene would be expected by those skilled in the art to be reactive with at least the sort of end units expected to be present in PPE and polyamide as well as the maleic anhydride moieties and residual unsaturation of the SEBS (admittedly which would be present in very small amounts), those skilled in the art would assume a graft would be formed.

When the reference discloses all the limitations of a claim except a property or function, and the Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note In re Fitzgerald et al. 619 F. 2d 67, 70, 205 USPQ 594, 596, (CCPA 1980). See MPEP § 2112-2112.02.

(10) Response to Argument

Applicants argue that glycidyloxy was deleted from claim 7 as a possible substituents for an aryl group of X. However the narrowing of a dependent claim can in no way be said to affect the scope of the independent claim from which it depended. An independent claim is broader than any dependent claim which properly depends from it and hence claim 1 necessarily encompassed glycidyloxy substituents on applicants aryl groups and since the narrowing of a dependent claim does not affect the scope of an independent claim, claim 1 still encompasses gycidyloxy. It is noted also that the same disclosure as that of original claim 7 is still in the specification and therefore even

ignoring the disclosure of claim 7 as filed those skilled in the art would assume that glycidyloxy substituents on applicants' aryl group were encompassed by claim 1. With regard to claim 7 as now amended it is noted that the penultimate line of claim 7 recites that aryl may be substituted by C1-C12alkyl and the C1-C12 is not recited to be unsubstituted and a C1 alkyl substituted by oxiranyl (i.e. an epoxy group) is the same as a glycidyl moiety. While applicants may argue that the C1 alkyl in the penultimate line of claim 7 is not recited to be substituted by oxiranyl or anything else, the fact that applicants' original dependent claims (as well as the specification) recited substituents on "aryl" despite the fact that the independent claim recited nothing about "aryl" being substituted would also conclude that any recited moiety (in the instant case C1alkyl) were open to substitution.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Jeffrey Mullis

/Jeffrey C. Mullis/

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